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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN FRANCISCO DIVISION

TRISTRATA, INC., a California
corporation,

Plaintiff,

v.

MICROSOFT CORPORATION, a
Washington corporation; and ADOBE
SYSTEMS INCORPORATED, a Delaware
corporation,

Defendants.

Case No. CV 11-3797 JSW

**DEFENDANTS' NOTICE OF MOTION
AND MOTION TO STRIKE THE LATE-
FILED DECLARATION OF DAVID
BERNSTEIN IN SUPPORT OF PLAINTIFF
TRISTRATA, INC.'S OPENING CLAIM
CONSTRUCTION BRIEF**

Date: January 18, 2013
Time: 9:00 A.M.
Place: Courtroom 11 – 19th Floor
Judge: Hon. Jeffrey S. White

NOTICE OF MOTION

TO ALL PARTIES AND THEIR COUNSEL OF RECORD:

PLEASE TAKE NOTICE that on January 18, 2013, at 9:00 a.m., or as soon thereafter as counsel may be heard, Defendants Adobe Systems Inc. (“Adobe”) and Microsoft Corporation (“Microsoft”) will, through their attorneys of record, move for an order: (1) striking the late-filed “Declaration Of David Bernstein In Support Of Plaintiff TriStrata, Inc.’s Opening Claim Construction Brief” (*see* Dkt. No. 60, hereinafter, the “Bernstein Declaration”); (2) giving the Bernstein Declaration no weight during claim construction; and (3) preventing any testimony by Mr. Bernstein based on his late-filed declaration. This Motion will be heard in the Courtroom of the Honorable Judge Jeffrey S. White for the United States District Court in the Northern District of California. The court is located at Courtroom 11 – 19th Floor, 450 Golden Gate Avenue, San Francisco, CA 94102.

Defendants Adobe and Microsoft respectfully submit this Motion on the grounds that the Bernstein Declaration was served on September 27, 2012 – 45 days after the August 13 deadline imposed by the Court’s June 19, 2012 Order (Dkt. No. 52 at 2) and Patent L.R. 4-3(e), and 15 days after the close of claim construction discovery (Dkt. No. 52 at 2). This Motion is based on this Notice of Motion, the Memorandum of Points and Authorities set forth below, the Declaration of Brock S. Weber submitted herewith, the pleadings and papers on file herein, and upon such other matters as may be presented to the Court at the time of the hearing.

Pursuant to Civil Local Rule 37-1, Defendants met and conferred with counsel for Plaintiff on October 5, 2012 to seek compliance with this Court’s scheduling Order and the Patent Local Rules by withdrawing the Bernstein Declaration. The parties were unable to reach agreement. (*See* Declaration of Brock S. Weber at ¶ 2.)

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I. MEMORANDUM OF POINTS AND AUTHORITIES

A. Introduction

Adobe and Microsoft respectfully request an order striking from the record the late-filed, second Declaration of David Bernstein in Support of Plaintiff TriStrata, Inc.’s Opening Claim Construction Brief (Dkt. No. 60) (“Bernstein Declaration”). The Bernstein Declaration was filed 45 days after the deadline imposed by the Court’s June 19, 2012 Order (Dkt. No. 52 at 2) and Patent L.R. 4-3(e), and 15 days after the close of claim construction discovery (Dkt. No. 52 at 2). Adobe and Microsoft, on the other hand, fully complied with those deadlines by serving expert declarations in support of their claim construction positions on August 13, 2012 (*See* Dkt. Nos. 53-2 and 52-3.) Adobe and Microsoft would be unfairly prejudiced if the Bernstein Declaration were not stricken because Plaintiff unilaterally gave itself 45 extra days to consider Defendants’ expert reports before filing its own, and deprived Defendants of the opportunity to depose Plaintiff’s expert on the bases for his proposed claim constructions. Plaintiff cannot show good cause for its delay and blatant disregard of the schedule in this case and, therefore, the Bernstein Declaration should be stricken and disregarded for purposes of claim construction.

B. Statement of Facts

According to the schedule stipulated to by the parties and as ordered by the Court, the parties filed their Joint Claim Construction and Prehearing Statement (“JCCPS”) on August 13, 2012 (Dkt. No. 53). Adobe and Microsoft submitted expert reports along with the JCCPS (Dkt. Nos. 53-2 and 53-3), but Plaintiff TriStrata, Inc. did not.

Two days after the August 13th deadline, Plaintiff served a “Supplement” to the JCCPS, which included the first “Declaration of David Bernstein” (Dkt. Nos. 54 and 54-1). Then, 45 days after the August 13th deadline, Plaintiff filed a *second* “Declaration of David Bernstein In Support of Plaintiff TriStrata, Inc.’s Opening Claim Construction Brief” on September 27, 2012 (Dkt. No. 60). This second declaration is the subject of the present Motion.

1 **C. Argument**

2 **1. The Bernstein Declaration Should be Stricken Because it Was Served**
 3 **Well After the Court's August 13th Deadline**

4 The Bernstein Declaration should be stricken because it was filed 45 days after the
 5 deadline imposed by the Court's June 19, 2012 Order and Patent L.R. 4-3(e). The Court's
 6 scheduling Order, which was based on a stipulation between the parties, required the JCCPS to be
 7 filed on August 13, 2012. (Dkt. No. 52 at 2.) Concurrently with the JCCPS, Patent Local Rule 4-
 8 3(e) requires the parties to submit any expert opinions that it will rely on for claim construction.
 9 Specifically, the JCCPS must contain the following information: "[w]hether any party proposes to
 10 call one or more witnesses at the Claim Construction Hearing, the identity of each such witness,
 11 and for each witness, a summary of his or her testimony including, for any expert, each opinion to
 12 be offered related to claim construction." Patent L.R. 4-3(e) (emphasis added).

13 Here, TriStrata did not serve "each opinion to be offered related to [its] claim
 14 construction[s]" until well after the deadline to do so. Plaintiff's first "supplemental" expert
 15 declaration was not served until August 15th. ("Declaration of David Bernstein," Dkt. No. 54-1.)
 16 However, this first expert declaration failed to specifically address the parties' competing claim
 17 constructions, and was largely incoherent and irrelevant. (*See id.*) The Bernstein Declaration at
 18 issue in this Motion was not filed until 45 days after the August 13th deadline, on September 27,
 19 2012. (Dkt. No. 60.) The Bernstein Declaration is a complete re-write and, for the first time,
 20 attempts to address the parties competing claim constructions. (*See id.*)

21 TriStrata may attempt to argue that it failed to file its expert reports on claim construction
 22 on time because it mistakenly thought that "Defendants proposed complying with the Local
 23 Patent Rules by providing [expert opinions] in connection with claim construction briefing." (*See*
 24 JCCPS, Dkt. No. 53 at 7.) However, Defendants never agreed to change the schedule imposed by
 25 the Patent Local Rules and the Court's June 19th scheduling Order. (*See id.*) Regardless,
 26 TriStrata's apparent misunderstanding of the case schedule could only explain its first late-filed
 27 expert report. TriStrata has no excuse for its decision to file a completely new expert report with
 28

1 its opening claim construction brief 45 days after the deadline to disclose expert opinions.

2 Therefore, the Bernstein Declaration, filed on September 27th (Dkt. No. 60), should be stricken
3 and given no weight during the upcoming claim construction proceedings.

4 **2. The Bernstein Declaration Was Served 15 days After Claim**
5 **Construction Discovery Closed and Defendants Will Suffer Unfair**
6 **Prejudice if it is Not Stricken**

7 The Bernstein Declaration was served 15 days after the September 12th deadline for claim
8 construction discovery, set by the Court's June 19th scheduling Order, and should therefore be
9 stricken. (Dkt. No. 52 at 2.) By the September 12th deadline, Patent Local Rule 4-4 requires the
10 parties to "complete all discovery relating to claim construction, including any depositions with
11 respect to claim construction of any witnesses, including experts, identified in the Preliminary
12 Claim Construction statement (Patent L.R. 4-2) or Joint Claim Construction and Prehearing
13 Statement (Patent L.R. 4-3)." Defendants made a calculated decision not to depose TriStrata's
14 expert, David Bernstein, based on his first "supplemental" declaration because it was incoherent
15 and irrelevant. Adobe and Microsoft are now unable to depose Mr. Bernstein based on the
16 Bernstein Declaration at issue here because claim construction discovery has closed.

17 Further, Plaintiff cannot show good cause for its significant delay in disclosing the expert
18 opinions upon which it intends to rely for claim construction. The rules are clear and the
19 Defendants complied with them fully. On the other hand, Plaintiff has now given itself the
20 opportunity to analyze Defendants' expert reports and 45 extra days to respond with its own, late-
21 filed expert report. The resulting unfair prejudice to Adobe and Microsoft cannot be cured except
22 by striking the Bernstein Declaration and giving it no weight during claim construction.

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II. CONCLUSION

For the foregoing reasons, Defendants Adobe and Microsoft respectfully request that the Court strike the late-filed “Declaration of David Bernstein In Support Of Plaintiff TriStrata, Inc.’s Opening Claim Construction Brief” (Dkt. No. 60) and disregard it during claim construction.

Dated: October 10, 2012

Respectfully submitted,

/s/ Eric L. Wesenberg

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Dated: October 10, 2012

/s/ Ian N. Feinberg

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ADOBE SYSTEMS INCORPORATED

CERTIFICATE OF SERVICE

The undersigned hereby certifies that all counsel of record who are deemed to have consented to electronic service are being served with a copy of this document via the Court's CM/ECF system pursuant to Civil L.R. 5-1(h)(1) on October 10, 2012. Any other counsel of record will be served via facsimile or electronic mail pursuant to Civil L.R. 5-1(h)(2).

/s/ Anna Freddie

Anna Freddie